

REMARKS

Claims 1-22 remain pending in this application. Allowance of claims 20 and 21, together with the indication of the allowability of depending claims 11, 16 and 19, are in order with the appreciation.

The Examiner again objected to the drawings under 37 C.F.R. §1.83 (a) as failing to illustrate the features defined by dependent claims 10-18. Applicant has tendered with this response additional formal drawings numbered Figures 1A, 2A, 3B, 3C, 4A and 5B to illustrate the features that the Examiner has asserted should be shown in accordance with rule 83. Fig. 1A clearly shows openings 12 arranged in an ornamental pattern while Fig. 2A shows the information 14 provided by a device borne by tab 7' and Fig. 5A shows the external surfaces of the clip marker providing a surface for application of the embossment, as defined by claim 18. Fig. 3C illustrates the under cover member 20 defined by claim 16, and together with Fig. 3B illustrates the wedge members defined by the claim 17. In view of the additional these figures therefore, the basis for the objection is removed.

Claims 1-6, 9, 11, 17 and 18 were rejected under 35 U.S.C. §102 (b) as anticipated by the Martin U.S. 2,448,611. Applicant again respectfully traverse this rejection for the following reasons.

Martin'611 discloses in Fig. 3, 4 and 7, a magnetic clip marker formed with a pair of rectangular wall members (6A and 6B, starting at point 12 and ending at fold line 22 as seen in Fig.

7) of equal and coextensive leints to the Examiner's assertion, Martin'611 is utterly devoid of any illustration of "overlapping" has the verb is commonly used in the United States.

In contradistinction, Applicant defines a pair of wall members aligned and jointed together, "with the pair of wall members comprised of the base portion and a clip portion *overlapping* said base portion to define the throat therebetween." Applicant has difficulty in understanding the Examiner's confusion about the verb "overlapping". Has the Examiner confused "overlapping" with "overlying" or "overlay"? *Overlapping* is not a synonym for *overlie*, it has a different meaning. Moreover, overlapping has no connotation of equality or coextensiveness in area. Both *Webster's Third New International Dictionary* (Unabridged) and the *New Shorter Oxford Dictionary* fail to support the Examiner's interpretation of "overlapping" as being equal or coextensive in area. Copies of the citations provided by these two references are encloses. If the Examiner's interpretation and understanding of the verb *overlapping* is based upon facts within a personal knowledge of the Examiner, the Examiner is respectfully requested to provide an affidavit as required under 37 C.F.R. §1.104 (d)(2) given those facts in order that Applicant might contradict the basis for the Examiner's continued assertion that these claims are anticipated by the identical surface areas of the Martin'611 patent.

Moreover, under the "all elements" rule of 35 U.S.C. §102 (b), and the utter absence of overlapping between the base and clip portion of the pair of wall members by Martin'611, there can be no anticipation. The "all elements" rule requires a teaching within a single reference of each and

every element defined by the claim to be rejected. Absent this, there is no anticipation.

Moreover, as was explained on pages 4 through 6 as Applicant's previously filed Amendment, and in contradiction of the Examiner's assertion set forth in the Advisory Action (Paper No. 19) dated 28 November 2001, Martin '611 expressly teaches that the magnets must be separated and then "placed in alignment on opposite side of the page to be marked." This is a contradistinction to Applicant's structure with the magnetic members aligned "to permit contact therebetween" that "permit the page of the book to be **readily received** within a throat of the clip marker." The Examiner's misrepresentation in the Paper No. 19 of the disclosure of Martin '611 is no substitute to for the absence of express teachings of Martin '611; moreover, it is improper to base the rejection upon the Examiner's misunderstanding or confusion about the express teachings of Martin '611, particularly with the differences are already recited in the Applicant's claims. Consequently, in view of the utter lack of any teaching or suggestion of Applicant's "overlapping" and "overlapping base portion and set clip portion" as defined by lines 1, 9 and 10 of parent claim 1, there is no basis for continuing this rejection. Its withdrawal is required.

Claims 7, 8, 10, 12 and 22 stand finally rejected under 35 U.S.C. §103(a) for alleged unpatentability over Martin '611. As noted in the foregoing paragraphs, Martin '611 lacks the interaction and combination of elements defined by parent claim 1. With respect claims 12 and 22, no court has ever held that in modification in the art involving "a mere change of size of a component" renders the claim obviousness. The Supreme Court itself has held in *Eibil Process*

Minnesota § Ontario Paper Co., 261 U.S.45, that a change of a single linear dimension provides patentability. No subordinate court has held otherwise. The significance of these distinctions is made evident by careful reading of Applicant's specification, particularly the discussion of the prior art set forth in the second, third and fourth paragraphs on page 2 of Applicant's originally filed specification. In summary, spaced apart magnetic elements are neither aligned with respect to one another nor in contact therebetween, and in the prior art, consequently are unable to provide Applicant's ability to "permit the page of a book to be read only received within set throat of the clip marker." The fact that the magnets may subsequently be placed together in alignment, with a page of a book already inserted into this throat of the clip, does not place those magnets in contact either physically, magnetically or operationally. The primary reference clearly teaches that the magnets must be functionally separated prior to insertion of the page. In short, Martin '611 fails to provide a *prima facie* showing of obviousness.

Claims 13 and 14 were finally rejected under 35 U.S.C§103(a) for alleged unpatentability over Martin '611 in view of Johnson U.S. Patent No. 2,630,777 while claims 15 was rejected under 35 U.S.C§103 for alleged unpatentability over Martin '611 in view of Schwartz U.S. Patent No. 5,380,043. Applicant respectfully traverses these rejections because supplementation of the primary reference with these secondary references fails to satisfy the foregoing omission in the primary reference. Accordingly, withdrawal of these rejections and allowance of these claims are required.

Claim 15 was rejected under 35 U.S.C§103(a) as rendered obvious over composed

combination of Marin '611 and Schwartz U.S.5,380,043. Applicant respectfully traverses this rejection for the following reasons.

First, Schwartz '043 fails to remedy the foregoing deficiencies on the primary reference. Consequently, there is no *prima facie* showing of obviousness.

Second, Schwartz '043 provides a leaf that maybe attached to one or more pages of a host book. The function of the book marker of Schwartz '611 however, is not provided by Schwartz '043. Moreover, there is no motivation for making the Examiner's proposed combination. Absent motivation, there is no obviousness. Withdraw of the rejections is therefore required.

Respectfully submitted,



Robert E. Bushnell,
Attorney for the Applicant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005-1245
(202) 408-9040

Folio: P56367
Date: 1/7/02
I.D.: REB

MARKED-UP VERSION OF AMENDMENTS
IN THE SPECIFICATION

Between paragraph 19, line 17-18 on page 4 and paragraph 20 line 19-22 on page 4 and line 1-2 on page 5, please insert the following paragraph:

--Fig. 1A illustrates an alternative embodiment with openings providing line identification on a page of a book.--

Between paragraph 20 line 19-22 on page 4 and line 1-2 on page 5, and paragraph 21, line 3-5 on page 5, please insert the following paragraph:

--Fig. 2A illustrates an exterior surface protruding from the throat, oriented to bear a device providing a display of information.--

Between paragraph 22, line 6-9 and paragraph 23, line 10-11 on page 5, please inset the following paragraphs:

--Fig. 3B illustrates edge members found on the base and clip portions.

Fig. 3C illustrates an outer cover member formed on the external surfaces of the page marker.--

Between paragraph 23 line 10-11 on page 5 and paragraph 24, line 12-15 in page 5, please insert the following paragraph:

--Fig. 4A illustrates circular wall members.--

Between paragraph 24 line 12-15 on page 5 and paragraph 25, line 16-19 on page 5, please insert the following paragraph:

--Fig. 5A illustrates an external surface providing an application surface for embossment.--

Please amend the paragraph 27 bridging pages 6 and 7, from line 22-25 on page 6 and line 1-2 on page 7, as follows:

Figure 2 shows the longer laminar wall (5) whose large surface (5') can be used to apply graphic prints such as advertising messages (14, 18), as is shown in Figures 2A and 5A, or ornaments and whose longitudinal edge (10) is a line [making means] marker (12), as is shown in greater detail by Figure 1A. At the joint (7) between both walls (2)(5) a tab (7') juts our outstanding notoriously from the edge (6') of the page (6). As is shown by Fig. 4A, both rolls (2)(5) maybe made circular, rather than square or rectangular.

Please amend the paragraph 29 on page 7, line 6-14, as follows:

Figure 3A shows an exploded view of Figure 3, wherein it can be seen in detail the first magnetic means (3) fixed to the shorter laminar wall (2) and to the second laminar wall (4) fixed to the longer laminar wall (5). Both magnetic means (3)(4) are covered by the cover (9), particularly its prominent edges (8). Therefore, the above mentioned cover (9) prevents the impingements between the page (6) and said prominent edges (8), facilitating the entrance thereof (6) into the clip (1). Figures 3B, 3C show edge elements 16 structurally arranged to cooperate with the magnetic members in order to permit the page of the book to be latterly received within the throat of the clip marker. Fig. 3C also shows outer cover members (20) borne by the external surfaces of the page marker opposite the throat opening.